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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/560,397 | 04/28/2000 | Stephen K. Boyer | STL9-2000-0029US1 | 4303 |

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EXAMINER

WOO, ISAAC M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2172

DATE MAILED: 07/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,397

Applicant(s)

BOYER ET AL.

Examiner

Isaac M Woo

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette (U.S. Patent No. 5,991,751, hereinafter, "Rivette").

With respect to claims 1, 10 and 19, Rivette discloses the method, computer program and system for determining potential licensees (col. 75, lines 32-67 to col. 76, lines 1-45) for a source patent portfolio composed of one or more patents where each patent has one or more references cited (col. 3, lines 19-51, col. 10, lines 58-67 to col. 11, lines 1-67 and col. 18, lines 55-67 to col. 19, lines 1-32), the method comprising:

devising a set of associated patents herein each patent in the set i) cites as a reference a patent in the source patent portfolio (forward reference, col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53) or ii) is cited as reference by a patent in the source

patent portfolio (backward reference, col. 4, lines 13-21, FIG. 86; col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73);

processing all of the patents in the set of associated patents to determine the assignees contained in the set (assignees searching), see (FIG. 53, col. 28, lines 1-51 and col. 93, lines 21-65);

removing from the assignees all assignees that are currently licensed, see (col. 103, lines 23-67 to col. 104, lines 1-67; col. 80, lines 63-67 to col. 81, lines 1-32 and FIG. 53-70); and

organizing the remaining assignees according to a ranking criteria, see (FIG. 104, col. 103, lines 23-67 to col. 104, lines 1-67; FIG. 59-63; FIG. 70; col. 95, lines 21-67 to col. 96, lines 1-15; FIG. 53, col. 28, lines 1-51 and col. 90, lines 55-67 to col. 91, lines 1-44; Note: displaying the results based upon assignees search combined with backward and forward references cited by either ascending or descending are ranking, thus, it is inherent that organizing according to ranking criteria).

With respect to claims 2, 11 and 20, Rivette discloses the adding, to the set of associated patents, patents that cite as a reference patents in the original set of associated patents (forward, col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53) or patents that are cited as a reference by a patent in the original set of associated patents, see (backward, col. 4, lines 13-21, FIG. 86, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73).

With respect to claims 3, 12 and 21, Rivette discloses the determining a set of cited references contained in the patents of the source patent portfolio (forwarding references and backward references);

adding, to the set of associated patents, patents that contain at least one of the references found in the set of cited references (reference cited), see (col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53; col. 4, lines 13-21; FIG. 86; col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73).

With respect to claims 4, 13 and 22, Rivette disclose that the source portfolio is the set of all patents assigned to a particular assignee, see (FIG. 53, col. col. 28, lines 1-51).

With respect to claims 5, 14 and 23, Rivette disclose that presenting the organized assignees in an HTML document that can be read by an Internet browser, see (FIG. 53, col. col. 28, lines 1-51 and col. 38, lines 25-67 to col. 39, lines 1-13).

With respect to claims 6-7, 15-16 and 24-25, Rivette discloses that the ranking criteria is the frequency of occurrence for each assignee in the set of associated patents, and the ranking criteria expressed as a ratio of the total umber of patents held by an assigned to the total number of patents meeting the criteria for the assignee in the set of correlated patents, see (col.103, lines 59-67 to col. 1-18).

With respect to claims 8, 17 and 26, Rivette discloses that the ranking criteria gives more weight to assignees having patents that have commonly cited references with patents in the source patent portfolio, see (col. 103, lines 25-67 to col. 104, lines 1-45).

With respect to claims 9, 18 and 27, Rivette discloses that the ranking criteria gives more weight to assignees both i) having patents that have a reference to a patent in the source patent portfolio (forward reference, col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53) and ii) having patents that are cited as a reference by a patent in the source patent portfolio, see (backward reference, col. 4, lines 13-21; FIG. 86; col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and col. 103, lines 25-67 to col. 104, lines 1-45).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Snyder et al (U.S. Patent No. 6,038,561) discloses the system for analyzing and displaying patents document searching.

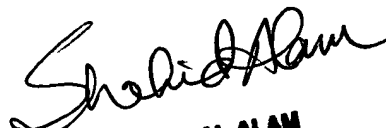
Rivette et al (U.S. Patent No. 5,991,751) discloses the system for searching analyzing and displaying patent documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

IMW
July 16, 2002


**SHAHID AL ALAM
PATENT EXAMINER**